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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,382	02/10/1999	RAMA MUKHERJEE	U012104-2	8689

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EXAMINER

MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 02/12/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/248,382

Applicant(s)

MUKHERJEE ET AL.

Examiner

Abdel A. Mohamed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2002 and 09 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

ACKNOWLEDGMENT FOR PRIORITY, AMENDMENTS, REMARKS, SEQUENCE LISTING, STATUS OF THE CLAIMS AND APPLICATION

1. Acknowledgment is made on 2/14/02 of Applicant's claim for priority based on Indian Application No. 343/DEL/98 having a filing date of 2/11/98. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file. The amendment and remarks filed 9/12/02 and the sequence listing filed 12/9/02, respectively are acknowledged, entered and considered. In view of Applicant's request claims 1-2, and 33-36 have been amended. Thus, claims 1-4 and 32-36 are pending in the application. The rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 103(a) over the prior art of record and the rejection under 35 U.S.C. 112, first paragraph have been withdrawn in view of Applicant's amendment and remarks filed 9/12/02.

The followings are new grounds of rejections

NEW GROUNDS OF REJECTIONS

HEADINGS FOR STATUTORY BASIS OF DOUBLE PATENTING

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg.*

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Co., 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

REJECTION UNDER 35 U.S.C. § 101 FOR DOUBLE PATENTING

3. Claim 2 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,492,330. Both claims are identical word for word (i.e., SEQ ID NOS:8-15 in claim 1 of the patent is the same as SEQ ID NOS:2-9 in claim 2 of the instant specification). This is a double patenting rejection.

HEADINGS FOR NONSTATUTORY DOUBLE PATENTING

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

DOUBLE PATENTING-NONSTATUTORY WITH A PATENT

5. Claims 1, 3, 4 and 32-36 are rejected under the under the judicially created doctrine of double patenting over claims 1-33 of U.S. Patent No. 6,492,330.

The subject matter claimed in the instant application is set forth in the '330 patent claims. The patent and the application claim common subject matter, as follows: The instantly claimed invention and the patent claim the use of peptides individually or in combination for the treatment of cancer. The only difference between the '330 patent claims and the claims of the instant application is the scope of the claims in which the instantly claimed invention is limited to peptidic sequences of SEQ ID NOS:1-9, wherein at least one of the amino acids at position 1-8 is replaced by Deg in SEQ ID NO:1 while the '330 patent claims is broadly directed to peptidic sequences of SEQ ID NOS:1-25 and the peptides are further used for treating angiogenesis. Both inventions are basically the same since they are made by the same procedure for the same

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purpose and SEQ ID NO:1 of the claimed invention is the same SEQ ID NO:2 of the patent and similarly SEQ ID NOS:2-9 is the same SEQ ID NOS:8-15 of the patent. Nevertheless, the only difference between the two inventions is the scope of the claims in which the invention of the instantly claimed invention appears to be specific in scope than that of the '330 patent which is broader because the patent's claims encompasses the use of peptidic sequences of SEQ ID NOS:1-25 for treatment of cancer and/or angiogenesis while the instantly claimed invention claims only the use of peptidic sequences of SEQ ID NOS:1-9 for treatment of cancer. Further, the instantly claimed invention is more specific in that the sequence of claim 1 (i.e., SEQ ID NO:1) could be replaced by Deg at least in one of the amino acid positions 1-8. However, one skilled in the art would easily replace at least one of the amino acid positions 1-8 of SEQ ID NO:1 by Deg (α - α -diethyl glycine) for the intended purpose of making the peptide more stable and resistant to enzymatic degradation. Thus, since both inventions are directed substantially to peptides isolated from the same source for the same purposes; it is conventional and would be within the purview of ordinary skill in the art to use or adapt either the broader scope or the specific because both procedures use substantially the same peptides for the same purposes. Therefore, both inventions are an obvious variation of the other since the same peptides are used for the same purpose, and as such, one of ordinary skill in the art would envision both sets of claims as one invention and obvious variation of each other.

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PROVISIONAL REJECTION OF OBVIOUSNESS-TYPE DOUBLE PATENTING

6. Claims 1, 3, 4 and 32-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/630,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed invention (Serial No. 09/248,381²) is directed to the use of peptides individually or in combination for the treatment of cancer having peptidic sequences of SEQ ID NOS:1-9, wherein at least one of the amino acids at position 1-8 is replaced by Deg in SEQ ID NO:1. Similarly, 09/630,345 is directed to use of peptides individually or in combination for the treatment of cancer having peptidic SEQ ID NOS:1-7. Both inventions are basically the same since they are made by the same procedure for the same purpose. Nevertheless, the only difference between the two inventions is the replacement of the sequences and the numbers of sequences disclosed. In the instant application the peptidic sequences disclosed are SEQ ID NOS:1-9 while in copending application SEQ ID NOS:1-7 have been disclosed. With respect to the replacement of sequences, SEQ ID NO:1 in claim 1 of the instant application could be replaced by Deg at least in one of the amino acid position 1-8 while the sequence recited in claim 1 of copending application the "X" could be replaced the alkanoyl groups. However, one skilled in the art would easily replace at least one of the amino acid positions 1-8 of SEQ ID NO:1 by Deg (α - α -diethyl glycine) for the intended purpose of making the peptide more stable and resistant to enzymatic degradation or by any of the alkanoyl groups recited in claim 2 of copending application for the purpose of protecting the

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peptide thereof. Thus, since both inventions are directed substantially to peptides isolated from the same source for the same purposes; it is conventional and would be within the purview of ordinary skill in the art to use or adapt either the Deg or the alkanoyl groups replacement because both procedures use substantially the same peptides for the same purposes. Therefore, both inventions are an obvious variation of the other since the same peptides are used for the same purpose, and as such, one of ordinary skill in the art would envision both sets of claims as one invention and obvious variation of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

CONCLUSION AND FUTURE CORRESPONDENCE

7. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 5:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

 Mohamed/AAM

January 31, 2003


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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